

REMARKS

In the December 28,2004 Office Action, the Examiner:

- Withdrew claims 78-84; and
- Rejected claims 55 and 75 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of Vann (“*Vann*”, U.S. Pat. No. 6,573,089 B1).

Restriction

The Examiner states that:

Since newly submitted claims 78-84 require directing light to the fibers, which has not found in original filed claim 55, claims 78-84 are directed to an invention that is independent or distinct from the invention previously claimed. Since applicant has received an action on the merits for the originally presented invention (claim 55), this invention has been constructively elected by original presentation on the merits. Accordingly claims 78-84 have been withdrawn from consideration as being directed to a non-elected invention.

Applicants are only required to restrict the claims to an invention previously claimed, if the newly presented claims are directed to an invention distinct from and independent of the invention previously claimed.¹ In other words, for a restriction to be proper, the subject matter of the newly added claims must be both distinct **AND** independent.

Independent claims 55 and 78 include the following elements:

Claim 55	Claim 78
immobilizing an immobilized chemical species on a fiber;	immobilizing an immobilized chemical species on at least a first one of a plurality of optical fibers;
placing said fiber on a support across a channel formed in said support; and	placing said plurality of fibers on a support having a plurality of channels;
disposing a mobile chemical species into said channel such that said mobile chemical species contacts said immobilized chemical species on said fiber.	disposing a mobile chemical species into at least a first one of said plurality of channels such that said mobile chemical species contacts at least said first one of a plurality of optical fibers;
	directing light to an end of said at least a first one of a plurality of optical fibers; and
	viewing the light emitted from said at least a first one of a plurality of optical fibers.

¹ See 37 CFR 1.145.

Independent claim 78 not only includes substantially all of the limitations of originally presented claim 55, but also adds two additional elements. Therefore, independent claims 55 and 78 cannot be independent of each other, as there is a disclosed relationship between the claimed subject matter, *i.e.*, the claims are connected by substantially the same operation and effect.² In addition, independent claims 55 and 78 are not distinct, as the common subject matter claimed in claims 55 and 78 are related and are not capable of separate use. Accordingly, it is respectfully submitted that the restriction is improper, as it has not been shown that the newly presented claims are directed to an invention that is both distinct from **AND** independent of the invention previously claimed.

In light of the above, it is respectfully requested that the Examiner reconsider the restriction requirement.

Claim Rejections – Double Patenting

Claims 55 and 75 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of *Vann*. Pursuant to 37 CFR 1.321(c), Applicants hereby submit a terminal disclaimer to overcome these provisional rejections.

Support

Independent claim 55 defines a single fiber and single channel embodiment of the invention. Support for the single fiber and channel embodiment can be found on page 6 of the Specification and is presented below for ease of reference.

According to one aspect of the invention there is provided a fiber array for contacting at least two chemical species. The fiber array comprises a support plate having a channel for receiving a mobile chemical species and a fiber, having a second chemical species immobilized thereon, disposed on the support plate. At least a portion of the fiber is exposed to the channel such that the mobile chemical species is capable of contacting the second chemical species.

In other words, from this paragraph alone it is clear that the specification provides the necessary support for the single fiber and single channel embodiment of claim 55. Support for dependent claims 75-77 are too numerous to mention and can be found throughout the Specification, such as in the description relating to Figures 1-16 and 33-34.

² See MPEP 802.01.

Independent claim 78 defines the same invention as independent claim 55 and includes the added limitations of multiple fibers and channels (as compared to the single fiber and channel of claim 55), directing light to an end of a fiber and viewing any emitted light. Support for these claims is also contained throughout the specification, such as in the description relating to Figures 1-16, which clearly show an array of multiple fibers and channels and a system for directing light at fibers and detecting light emitted from the fibers.

Claim term "across"

The Examiner has indicated that the claim term "across" may be unclear. Independent claim 55 requires placing the fiber on a support across a channel formed in the support. while independent claim 78 has been amended to clarify that each fiber of the plurality of fibers is oriented across a width of one or more of the channels. Applicants respectfully submit that the term "across" is both clear and unambiguous. The plain and ordinary meaning of the term "across," as evidenced by its dictionary definition,³ is "so as to cross; from one side to the other,"⁴ such as - a bridge across a river. In other words, a fiber placed across a channel is a fiber that crosses the channel from one side to the other. This is further evidenced from the figures, such as Figure 1 or 10, that clearly show a fiber that crosses a channel from one side to the other, or is placed across a channel.

In light of the above, it respectfully requested that the Examiner reconsider any objections to the term "across."

³ "It is well settled that dictionary definitions provide evidence of a claim term's 'ordinary meaning'." *CCS Fitness Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002).

⁴ The American Heritage College Dictionary, 12 (3rd Ed.) 1997.


CONCLUSION

In view of the foregoing argument and the terminal disclaimer, it is respectfully submitted that the application is now in a condition for allowance. However, should the Examiner believe that the claims are not in condition for allowance, the Applicant encourages the Examiner to call the undersigned attorney at 650-843-7519 to set up an interview.

If there are any fees or credits due in connection with the filing of this Amendment, including any fees required for an Extension of Time under 37 C.F.R. Section 1.136, authorization is given to charge any necessary fees to our Deposit Account No. 50-0310 (order No. 061193-0049-US). A copy of this sheet is enclosed for such purpose.

Respectfully submitted,

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